
FULL TEXT OF CASES (USPQ2D)

All Other Cases

Ex parte Novitski (BdPatApp&Int) 26 USPQ2d 1389 (1/22/1993)

Ex parte Novitski (BdPatApp&Int) 26 USPQ2d 1389

Ex parte Novitski

**U.S. Patent and Trademark Office, Board of Patent Appeals and
Interferences**

26 USPQ2d 1389

Decided January 22, 1993

No. 92-1680

Headnotes

PATENTS

1. Patentability/Validity -- Anticipation -- Prior art (§ 115.0703)

Claimed method for protecting plants from nematodes is anticipated by prior art reference which, although it does not disclose claimed method in haec verba, does disclose method of inoculating plant with "pseudomonas cepacia type Wisconsin 526," which inherently possesses nematode-inhibiting activity.

Case History and Disposition:

Page 1389

Appeal from refusal to allow claims 1 through 9 (Elizabeth C. Weimar, supervisory patent examiner; Che S. Chereskin, examiner).

Application for patent filed July 1, 1988, serial no. 07/214,301, by Charles Novitski, Thomas J. McLoughlin, and Howard Atkinson (method for protecting plants from nematodes). From examiner's decision refusing to allow claims 1 through 9, applicants appeal. Examiner's rejection of claims under 35 USC 103 reversed; new ground of rejection under 35 USC 102 entered.

Judge:

Before Goldstein, Winters, and W. Smith, examiners-in-chief.

Page 1390

Opinion Text

Opinion By:

Winters, examiner-in-chief.

This appeal is from the examiner's decision refusing to allow claims 1 through 9. Claims 10 and 11, which are the only other claims in the application, stand objected to as depending from a rejected claim.

Claim 1 is representative:

1. A method for protecting a plant from plant pathogenic nematodes which comprises the step of inoculating said plant with a nematode-inhibiting strain of *P. cepacia* which strain colonizes said plant.

The references relied on by the examiner are:

Dart et al. (Dart) 4,798,723 Jan. 17, 1989 Sayre, *Journal of Nematology*, Vol. 12, No. 4, "Biocontrol: *Bacillus Penetrans* and Related Parasites of Nematodes", pages 260-269 (1980). Hoitink, *Annual Review Phytopathol*, Vol. 24, "Basis for the Control of Soilborne Plant Pathogens with Composts", pages 93-114 (1986). Mishra et al. (Mishra), *Journal of Industrial Microbiology*, Vol. 2, "Insecticidal and Nematicidal Properties of Microbial Metabolites", pages 267-276 (1987).

The issue presented for review is whether the examiner correctly rejected claims 1 through 9 under 35 USC 103 as unpatentable over the combined disclosures of Dart, Sayre, Hoitink, and Mishra.

OPINION

We shall not sustain this rejection.

In setting forth the prior art rejection under 35 USC 103, the examiner identifies Dart as a "primary" reference. According to the examiner, Dart discloses every feature of the subject matter sought to be patented in independent claim 1 *except that*: (1) Dart does not expressly disclose that his bacterial strains of *Pseudomonas cepacia* type Wisconsin possess nematode-inhibiting activity; and (2) Dart does not expressly disclose a method for protecting a plant from plant pathogenic nematodes. As succinctly stated by the examiner,

Dart et al. differs from the claimed invention in that the usefulness of *P. cepacia* to control nematodes is not disclosed.

See the Examiner's Answer, page 3, last complete paragraph.

The examiner relies on Sayre, Hoitink, and Mishra as "secondary" references which make up for the above-noted deficiency of Dart. According to the examiner, the combined disclosures of the "primary" and "secondary" references would have led a person having ordinary skill in the art to the claimed method for protecting a plant from plant pathogenic nematodes with a "reasonable expectation of success". We disagree.

When all the prior art is considered together, a person having ordinary skill in the art must have a sufficient basis for the necessary predictability of success to sustain a rejection under 35 USC 103. *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976). Here, the "secondary" references relied on by the examiner do not teach or suggest that Dart's bacterial strains of *Pseudomonas cepacia* type Wisconsin may reasonably be expected to possess nematode-inhibiting activity. The "secondary" references relate to screening bacteria for nematode-inhibiting activity and, at the most, attribute such activity to several strains of *Pseudomonas* bacteria which are not *Pseudomonas cepacia*. In our judgment, the "secondary" art falls far short of establishing that Dart's bacterial strains of *Pseudomonas cepacia* type Wisconsin would reasonably be expected to possess nematode-inhibiting activity.

Under the provisions of 37 CFR 1.196(b), we enter the following new ground of rejection.

Claims 1 through 9 are rejected under 35 USC 102 as anticipated by Dart.